Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ZULIN SHI, JEFF ALIX, HUI-CHEN LI,
PAUL NOWACZYK and JIUNN-YANN TANG,

_____

Appeal No. 2002-0866
Application No. 09/262,471[1]

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ON BRIEF

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Before GARRIS, PAK, and MOORE, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1, 2, 6, 8 through 18 and 20, which are all of the claims pending in the above-identified

[1] Application for patent filed March 4, 1999.

application. Claim 6 was amended subsequent to the final Office action dated September 26, 2000. See the Advisory Action dated January 29, 2001, Paper No. 10.

APPEALED SUBJECT MATTER

Claims 1, 14, 17 and 18 are representative of the subject matter on appeal and a copy of these claims is appended to this decision.

PRIOR ART

The examiner relies on the following prior art references:

Van Delft et al. (Delft)	4,076,852	Feb. 28, 1978
Van den Heuvel et al. (Heuvel)	5,368,876	Nov. 29, 1994

REJECTION

The appealed claims stand rejected as follows:

1) Claims 1, 2, 6, 8 through 13, 15 through 17 and 20 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Delft; and

2) Claims 14 and 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Delft and Heuvel.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the evidence and arguments advanced

by both the examiner and the appellants in support of their respective positions. As a consequence of this review, we have made the determinations which follow.

We turn first to the examiner's rejection of Claims 1, 2, 6, 8 through 13, 15 through 17 and 20 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Delft. We find that Delft exemplifies a mixture useful for imparting chicken flavor to foods, inclusive of a pet food, wherein the mixture is produced by combining, *inter alia*, L-cysteine hydrochloride, a carbohydrate, such as dextrose or arabinose, and an animal digest (chicken fat and powder chicken meat) at a reflux temperature (an elevated temperature). See column 15, Examples XXIII-XXVII. Although Delft exemplifies using L-cysteine hydrochloride as the sulfur containing compound useful for forming the above-mentioned mixture, it lists other sulfur containing compounds, such as ammonium sulfide and hydrogen sulfide, which can be utilized for the same purpose. See column 5, line 65 to column 6, line 51. Delft also lists other equally useful carbohydrates, such as d-xylose, ribose and sucrose. See column 7, lines 2-8.

To arrive at the claimed mixture, both the examiner and the appellants recognize that ammonium sulfide must be selected from the large number of sulfur containing compounds listed in Delft. See, e.g., the Answer, page 7 and the Brief, pages 5 and 6. While some picking and choosing may be appropriate in making an obviousness rejection under 35 U.S.C. § 103, it is entirely improper in making a rejection under 35 U.S.C. § 102(b) for anticipation. *See In re Arkley*, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972). Delft simply does not describe the claimed invention with a sufficient degree of specificity to constitute "anticipation" within the purview of 35 U.S.C. § 102(b). *See In re Schaumann*, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978). Accordingly, we reverse the examiner's rejection of claims 1, 2, 6, 8 through 13, 15 through 17 and 20 under 35 U.S.C. § 102(b).

We turn next to the examiner's rejection of claims 14 and 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Delft and Heuvel. The examiner's Section 103 rejection is premised upon obviousness of including 3-methyl thiophene taught in Heuvel in a mixture corresponding to that

recited in claim 1. See the Answer, pages 3-5. The examiner, however, does not explain why and how one of ordinary skill in the art would have been led to a mixture corresponding to the mixture recited in claim 1. Due to the examiner's incorrect assumptions regarding the teachings of Delft as indicated *supra*, the examiner's reasons for obviousness are incomplete. Accordingly, we are constrained to procedurally reverse this rejection.

We want to make clear, however, that this is a technical reversal, rather than one based upon the merits of the applied prior art references. The sufficiency of the prior art teachings have not been ascertained at this time because the examiner's Section 103 rejection is based on incorrect assumptions as indicated *supra*.

REMAND ORDER

For the findings of fact set forth above and in the Answer, we determine that Delft would have rendered the subject matter defined by at least claims 1, 17 and 20 *prima facie* obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 and that Delft's working Examples XXIII-XXVII represent

prior art embodiments closest to the claimed subject matter. Therefore, upon return of this application, the examiner is to determine:

1) Whether Delft alone, or in combination with Heuvel, would have render the subject matter defined by the remaining claims *prima facie* obvious to one of ordinary skill in the art; and

2) whether any *prima facie* case of obviousness established by Delft alone and/or in combination with Heuvel is rebutted by the showing of unexpected results relied upon by the appellants in the form of a Rule 132 declaration executed by Dr. Zulin Shi.

In assessing the sufficiency of the showing, the examiner is to determine:

1) Whether the appellants have demonstrated that the showing is directed either directly or indirectly to a comparison between the claimed invention and the closest prior art embodiments in Delft[2];

2) Whether the appellants have demonstrated that the showing is reasonably commensurate in scope with the claims on appeal[3];

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[2] *In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

[3] *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990)("'[O]bjective evidence of nonobviousness must be commensurate in scope with the claims.'"); *In re Dill*, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA

and

3) Whether the appellants have demonstrated that the tests utilized to prove an unexpectedly superior flavor in the showing are well accepted in the art (standard in the food industry). The examiner must keep in mind that the burden of showing unexpected results rests on the appellants. *In re Freeman*, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972).

CONCLUSION

In view of the foregoing, we reverse the examiner's aforementioned Sections 102 and 103 rejections and remand the application to the examiner for appropriate action consistent with the views expressed *supra*.

REQUIREMENTS

This application, by virtue of its "special" status, requires immediate action on part of the examiner. See MPEP § 708.01(D)(8th Ed., Aug. 2001). It is important that the

1979)("The evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to which it pertains.").

examiner promptly informs the Board of Patent Appeals and Interferences of any action affecting the appeal in this case.

REVERSED/REMANDED

BRADLEY R. GARRIS Administrative Patent Judge	)	
CHUNG K. PAK Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMES T. MOORE Administrative Patent Judge	)	

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APPENDIX
Claims 1, 14, 17, 18

1. A method for producing pet food flavors comprising combining at elevated temperature ammonium sulfide, at least one reducing carbohydrate, an animal digest and optionally at least one nitrogen containing compound to form a reaction product.

14. The method of claim 1 wherein said reaction product includes at least 3-methyl thiophene.

17. A flavorant for an animal pet food prepared by a process comprising combining at elevated temperature ammonium sulfide and at least one reducing carbohydrate and an animal digest to form a reaction product.

18. A pet food flavorant comprised of water, 3-methyl thiophene, a reducing sugar, an animal digest, and at least one compound selected from 2-ethyl furan; 2,3-dihydrothiophene; methyl pyrazine; 2-furanmethanol; ethyl pyrazine; 2-ethyl-5-methyl pyrazine; 2-methyl-6-(methio)-pyrazine; 2,5-dimethyl furan; 2-methyl thiophene; methyl ethyl disulfide; 2,5-dimethylpyrazine; 2-methyl-1-ethyl pyrrolidine; 2-ethyl-6-methyl pyrazine; 2-[(methyldithio)methyl]-furan; pyrazine; 2-(2-propenyl)-furan-, 2,6-dimethylpyrazine; dimethyl trisulfide (DMTS); 5-methyl-2- thiophenecarboxaldehyde; benzo[b]thiophene-4-ol; propanoic acid; 4-methyl thiazole; 2,5-dimethyl thiophene; ethyl thiazone; dihydro-2-methyl-3(2H)-thiophene; methyl-2-methyl-3-furyl disulfide and mixtures thereof.